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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/590,630	11/16/2007	Gert Bolander Jensen	14455.946US01	2291
43439 7590 08/11/2009 BERENBAUM WEINSHIENK PC 370 17TH STREET SUITE 4800 DENVER, CO 80202			EXAMINER KIM, YOUNG J	
			ART UNIT 1637	PAPER NUMBER
			NOTIFICATION DATE 08/11/2009	DELIVERY MODE ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

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Office Action Summary	Application No. 10/590,630	Applicant(s) JENSEN ET AL.	
	Examiner Young J. Kim	Art Unit 1637	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 20 May 2009.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-11 and 14-16 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-11 and 14-16 is/are rejected.
- 7) ☒ Claim(s) 11, 18 and 19 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

The present Office Action is responsive to the Amendment received on May 20, 2009.

Preliminary Remark

Claims 12, 13, and 17-22 are canceled.

Claims 1-11 and 14-16 are pending and are under prosecution herein.

Specification

The specification is objected to for the informalities noted in the Office Action mailed on November 20, 2008 is withdrawn in view of the Amendment received on May 20, 2009.

Claim Objections

The objection to claims 11, 18, and 19 for informalities noted in the Office Action mailed on November 20, 2008 is withdrawn in view of the Amendment received on May 20, 2009.

Claims 2, 4, and 6 are objected for the following minor informalities:

a) claim 2 recites the phrase, "the first and a second electrode." It would appear that the term, "a" should be, "the".

b) claim 4 recites the phrase, "alternating electric field is at the least ..." It would appear that the term, "the" could be deleted.

c) claim 6 recites the phrase, "wherein the alternating electric field created by ..." It would appear that the word, "is" should be inserted between the words, "field" and "created."

Claim Rejections - 35 USC § 112

The rejection of claims 10 and 15-19 under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter, made in the

Art Unit: 1637

Office Action mailed on November 20, 2008 is withdrawn in view of the Amendment received on May 20, 2009. Applicants' statement regarding which claims correspond to the rejected claims is correct. Examiner appreciates Applicants' attempt to address the concerns made in the previous action.

Claim Rejections - 35 USC § 102

The rejection of claims 15-17 (which corresponds to instant claims 18-20) under 35 U.S.C. 102(b) as being anticipated by Mainelis et al. (Aerosol Science and Technology, 1997, vol. 30, pages 127-144; IDS ref # 54), made in the Office Action mailed on November 20, 2008 is withdrawn in view of the Amendment received on May 20, 2009, canceling claims 18-20, which correctly correspond to the substance rejected by the instant rejection of record.

The rejection of claims 15-19 (which corresponds to instant claims 18-22) under 35 U.S.C. 102(b) as being anticipated by Mainelis et al. (Aerosol Science and Technology, 2002, vol. 36, pages 1073-1085; IDS ref# 56), made in the Office Action mailed on November 20, 2008 is withdrawn in view of the Amendment received on May 20, 2009, canceling claims 18-22, which correctly correspond to the substance rejected by the instant rejection of record.

Claim Rejections - 35 USC § 103

The rejection of claims 1-3 and 5-14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Birmingham et al. (U.S. Patent No. 5,989,824, issued November 23, 1999) in view of Mainelis et al. (Aerosol Science and Technology February 2002, vol. 36, pages 1073-1085; IDS¹ ref# 56), made in the Office Action mailed on November 20, 2008 is withdrawn in view of the

Art Unit: 1637

Amendment received on May 20, 2009. In particular, Applicants' arguments were founding convincing.

The rejection of claims 4 and 15-19 under 35 U.S.C. 103(a) as being unpatentable over Birmingham et al. (U.S. Patent No. 5,989,824, issued November 23, 1999) in view of Mainelis et al. (Aerosol Science and Technology February 2002, vol. 36, pages 1073-1085; IDS² ref# 56), as applied to claims 1, 2, and 17 above, and further in view of Johns et al. (Letters in Applied Microbiology, 1994, vol. 18, pages 236-238; IDS³ ref# 47), made in the Office Action mailed on November 20, 2008 is withdrawn in view of the Amendment received on May 20, 2009.

Double Patenting

The provisional rejection of claims 12, 13, and 17-22 on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-18 of copending Application No. 10/590,632, made in the Office Action mailed on November 20, 2008 is withdrawn in view of the Amendment received on May 20, 2008, canceling the rejected claims.

The provisional rejection of claims 12, 13, and 17-22 on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-13 of copending Application No. 10/590,768, made in the Office Action mailed on November 20, 2008 is withdrawn in view of the Amendment received on May 20, 2008, canceling the rejected claims.

Rejections, Maintained

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is

¹ IDS received on January 25, 2007

² IDS received on January 25, 2007

Art Unit: 1637

appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

The provisional rejection of claims 1-11 and 14-16 on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-18 of copending Application No. 10/590,632, made in the Office Action mailed on November 20, 2008 is maintained for the reasons already of record.

The provisional rejection of claims 1-11 and 14-16 on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-13 of copending Application No. 10/590,768, made in the Office Action mailed on November 20, 2008 is maintained for the reasons already of record.

The conflicting applications and the instant application have the same filing date as well as the effective filing date (from the same parent application).

In this situation, MPEP 804(I)(B)(1) states:

If both applications are filed on the same day, the examiner should determine which application claims the base invention and which application claims the improvement (added limitations). The ODP rejection in the base application can be withdrawn without a terminal disclaimer, while the ODP rejection in the improvement application cannot be withdrawn without a terminal disclaimer.

Art Unit: 1637

Instant invention is not determined to be the “base” invention nor the conflicting applications an “improvement” thereof. Therefore, a terminal disclaimer must be filed in order to overcome the rejections of record.

MPEP further states:

Where there are three applications containing claims that conflict such that an ODP rejection is made in each application based upon the other two, *it is not sufficient to file a terminal disclaimer in only one of the applications addressing the other two applications. Rather, an appropriate terminal disclaimer must be filed in at least two of the applications to link all three together.* This is because a terminal disclaimer filed to obviate a double patenting rejection is effective only with respect to the application in which the terminal disclaimer is filed; it is not effective to link the other two applications to each other.

Conclusion

No claims are allowed.

The prior art neither discloses or suggests for a method of analyzing bacteria spores in a liquid sample, wherein the liquid sample comprising the bacteria spore is provided in a sample chamber located between a first and second electrode and the spore in said liquid sample is lysed/ruptured by the application of an alternating electric field so as to extract the biological materials therein.

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on

Art Unit: 1637

the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Inquiries

Any inquiry concerning this communication or earlier communications from the Examiner should be directed to Young J. Kim whose telephone number is (571) 272-0785. The Examiner is on flex-time schedule and can best be reached from 9:00 a.m. to 5:30 p.m (M-F). The Examiner can also be reached via e-mail to Young.Kim@uspto.gov. However, the office cannot guarantee security through the e-mail system nor should official papers be transmitted through this route.

If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's supervisor, Dr. Gary Benzion, can be reached at (571) 272-0782.

Papers related to this application may be submitted to Art Unit 1637 by facsimile transmission. The faxing of such papers must conform with the notice published in the Official Gazette, 1156 OG 61 (November 16, 1993) and 1157 OG 94 (December 28, 1993) (see 37 CFR 1.6(d)). NOTE: If applicant does submit a paper by FAX, the original copy should be retained by applicant or applicant's representative. NO DUPLICATE COPIES SHOULD BE SUBMITTED, so as to avoid the processing of duplicate papers in the Office. All official documents must be sent to the Official Tech Center Fax number: (571) 273-8300. For Unofficial documents, faxes can be sent directly to the Examiner at (571) 273-0785. Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (571) 272-1600.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system,

Art Unit: 1637

see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Young J. Kim/
Primary Examiner
Art Unit 1637
8/7/2009

/YJK/